

## **REMARKS**

In the Office Action, the Examiner rejected claims 19 and 20 under 35 USC § 251, and rejected claims 19 and 20 under 35 USC § 103(a). These rejections are fully traversed below.

Claims 21-46 have been added to the application. Thus, claims 19-46 are currently pending and presented for reconsideration.

In item 1 on page 2 of the Office Action, the Examiner requested a reference to the parent reissue application. Applicants have amended page 1 of the specification to include a reference to the parent reissue application, namely, U.S. Application No. 09/137,960, now RE37,493.

In item 2 on page 2 of the Office Action, the Examiner commented on the format of the previously added claims 19 and 20. All claims are now presented in underlined fashion given that the present application is a reissue application.

In item 3 on pages 2 and 3 of the Office Action, the Examiner rejected claims 19 and 20 under 35 USC § 251 as being "improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the reissue is based." In effect, the Examiner is asserting that Applicant is attempting to eliminate claim language in the instant application that was used to distinguish the invention during prosecution in the parent application (08/158,989). This, however, is simply not the case.

The Examiner makes particular reference to claims 26 and 29 of parent application 08/158,989. In the parent application, by way of an amendment filed December 7, 1995, parent claims 26-31 (among other claims) were cancelled from the application in order to expedite allowance. Such amendment, in effect, substantially accepted the subject matter that was previously indicated by the Examiner as being allowable. Hence, parent claims 26-31 were cancelled to expedite prosecution and were not a relinquishment of subject matter by the Applicant.

Moreover, the cancellation of these claims eliminated all method claims from the application and thus there were no amendments to add additional limitations to other existing method claims so as to distinguish the invention during prosecution of the parent application.

Even if the cancellation of parent claims 26-31 were a relinquishment of subject matter, such would constitute a correctable error because it was without deceptive intent.

The Examiner identifies four areas of difference between claims 19 and 20 of the pending application and claims 26 and 29 of parent application 08/158,989.

Specifically, the Examiner states:

(1) the present claims recite sensing or monitoring infrared energy "within a predetermined area"; (2) the present claims recite filtering out infrared energy "not within a predetermined frequency range"; (3) the parent claim 29 recited "converting the infrared energy into electrical signals" prior to the filtering step (see lines 3-4 of the incorporated claim 26), i.e., "the filtered energy signals" were defined as "filtered electrical signals"; and (4) the parent claim 29 recited a "plurality" of infrared sensors. Thus, present claims 19 and 20 are "narrower" than parent claim 29 due to items (1) and (2), and "broader" than parent claim 29 due to items (3) and (4). However, items (1) and (2) are considered inherent aspects of the method set forth in parent claim 29, and thus do not truly "narrow" the surrendered subject matter of parent claim 29, ..."

Office Action, pages 2 and 3.

Assuming *arguendo* that items (3) and (4) do broaden claim 19 as compared to parent claim 29, these aspects of claims 19 and 20 do not relate to surrendered subject matter. There are no arguments in the parent application's prosecution history regarding arguments or changes to any method claims made in an effort to overcome a prior art rejection. Indeed, none of items (1) through (4) identified by the Examiner were "originally presented/argued/stated in the original application to make the claims allowable over a rejection or objection made in the original application." MPEP 1412.02 (criteria for determining that subject matter has been surrendered). Hence, in the parent application, the method claims were completely cancelled from the application following their rejection. Hence, no method claims were patented in the original patent and thus there are no limitations to be considered as being omitted or broadened with respect to the original patent claims.

Still further item (2) pertains to filtering out the infrared energy not within a predetermined frequency range. Parent claim 26 recited filtering of electrical signals. Hence, it is submitted that item (2) of claim 19 is narrower than the filtering recited in parent claim 26. Moreover, item (1) adds additional language that further specifies how the monitoring is performed. In other words, item (1) narrows the monitoring to a specific area, namely, the predetermined area. Hence, claim 19 is not improper recapture because it is narrower than cancelled patent claims 29-31 in at least one respect.

Accordingly, it is respectfully requested that the Examiner reconsider and withdraw the rejection of claims 19 and 20 under 35 USC § 251.

In item 5 on page 4 of the Office Action, the Examiner rejected claims 19 and 20 under 35 USC § 103(a) as being unpatentable over *Odashima* (US Patent No. 4,671,362) in view of *McMenamin* (US Patent No. 3,665,440). This rejection is fully traversed below.

In rejecting claims 19 and 20, the Examiner relies on a combination of *Odashima* and *McMenamin*. Specifically, the Examiner proposes to combine the bandpass amplifier 14 of *McMenamin* with the filter 15 of *Odashima*. In *Odashima*, the filter 15 is an infrared-ray passing filter. As shown in Fig. 3, the filter 15 is an optical filter, not an electronic filter. Whereas, in *McMenamin*, the bandpass amplifier 14 is an electronic device. Hence, one skilled in the art would not be motivated to combine the optical filter 15 of *Odashima* with the electronic bandpass amplifier 14 of *McMenamin*. Moreover, neither of these references provide any hint, motivation or suggestion to combine the references in the manner proposed by the Examiner. Accordingly, for at least these reasons, it is submitted that claims 19 and 20 are patentably distinct over *Odashima* in view of *McMenamin*.

### **SUMMARY**

It is submitted that claims 19 and 20 are patentably distinct over *Odashima* in view of *McMenamin*. In addition, it is submitted that claims 19 and 20 do not violate 35 USC § 251 regarding recapture. Reconsideration of the application and an early notice of allowance are earnestly solicited.

If there are any issues remaining which the Examiner believes could be resolved through either a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number listed below.

Applicant hereby petitions for an extension of time which may be required to maintain the pendency of this case, and any required fee for such extension or any

further fee required in connection with the filing of this Amendment is to be charged to  
Deposit Account No. 500388 (Order No. AET1P001R2).

Respectfully submitted,

BEYER WEAVER & THOMAS, LLP

A handwritten signature in black ink, appearing to read "C. Douglass Thomas", written over the printed name.

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